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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte DOMINIQUE BRIERE, LEON COLSY,
PAUL LA BARRE, PASCAL SANTAIS

Appeal 2009-006274
Reissue Application 09/902,475
Technology Center 1700

Oral Hearing Held: July 8, 2009

Before ALLEN R. MacDONALD, *Vice-Chief Administrative Patent Judge*,
and BRADLEY R. GARRIS, *Administrative Patent Judge*, and
FRED E. McKELVEY, *Senior Administrative Patent Judge*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

Jeffrey E. Young, Esquire
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PROCEEDINGS

MS. COOK: Good afternoon. Calendar No. 23, Appeal 2009-6274,
Mr. Jeffrey E. Young, attorney for Appellant.

JUDGE McKELVEY: Mr. Cooper, you're—I want to make sure I
can hear you, if you'd just say something in the microphone there.

MR. YOUNG: May it please the Board, this is Jeffrey Young.

JUDGE McKELVEY: Oh, Young. Yeah, Mr. Young.

MR. YOUNG: Yes, sir. I am appearing on behalf of the Appellant
assignee, Sidel SA.

JUDGE MacDONALD: Is this your first time here?

MR. YOUNG: No.

JUDGE MacDONALD: Okay, so you know you have 20 minutes and
you may proceed.

MR. YOUNG: Yes. All right, thank you.

This appeal is—this application is a continuation of an application
filed to seek reissue of U.S. Patent 5,968,560. The parent reissue application
resulted in Reissue Patent No. 39,769.

JUDGE McKELVEY: Mr. Young, I take it if you prevail here, your
object is to reissue the reissued patent and get some additional claims into it?

MR. YOUNG: Well, sir, the—as a continuation of the reissue the—I
guess our goal is to correct an additional defect in the original patent.

JUDGE McKELVEY: Okay, so you end up with two reissue patents?

MR. YOUNG: Yes, sir.

JUDGE McKELVEY: Okay. I'd like you to—do you have your
Reply Brief available?

1 MR. YOUNG: Yes, sir.

2 JUDGE McKELVEY: Page 3.

3 MR. YOUNG: Yes, sir.

4 JUDGE McKELVEY: I want to be clear about a part. You see the
5 bolded part in your claim down at the bottom there?

6 MR. YOUNG: Yes, sir.

7 JUDGE McKELVEY: I take it that it is the two mold carriers which
8 are made in the form of the enveloping structures as opposed to the half
9 molds? The --

10 MR. YOUNG: Yes.

11 JUDGE McKELVEY: Okay.

12 MR. YOUNG: Yes, sir.

13 JUDGE McKELVEY: Now then, the next question I got here, and
14 Judge MacDonald will give you some time to present something. I just have
15 some questions here. Is your claim 48, which appears on page 4 of the claim
16 appendix in the brief or wherever, if you can get that.

17 MR. YOUNG: Yes, Your Honor, I have it.

18 JUDGE McKELVEY: Okay. It would help us a lot if you can clarify
19 the scope of this claim. Can you infringe this claim without having a mold
20 carrier?

21 MR. YOUNG: You can, yes, sir, so long as the mold shell is
22 configured to be supported by mold carriers formed—made in the form of
23 enveloping structures via mold shell holders which are shaped to be
24 supported by mold carriers made in the form of enveloping structures.

25

1 JUDGE McKELVEY: But let's say that the mold shell is configured
2 that way. This claim doesn't exclude using some other mold carrier, does it,
3 using—or in other words using the mold shell in another carrier as long as
4 the carrier would be capable of doing what you say?

5 MR. YOUNG: I believe that's true, sir.

6 JUDGE McKELVEY: So why haven't you eliminated from claim 1
7 of the patent not only the part about—that you added about which are made
8 in the form of enveloping structures, but you've eliminated the whole mold
9 carrier from this claim.

10 MR. YOUNG: Well, Your Honor, the—what the Patent Owner seeks
11 to do in reissue here is to claim a subcombination. It is a broadening reissue,
12 and so the main question I believe is whether the—is whether we are
13 recapturing any subject matter pertaining to the claim mold shell
14 subcombination that was surrendered to get the '560 patent issued.

15 JUDGE McKELVEY: Well, it seems to me that your original claim
16 required a mold shell and a mold carrier, and you've eliminated the carrier
17 altogether. Now in order to get this claim allowed, you had to put in a
18 limitation relative to the mold carrier.

19 MR. YOUNG: That's correct. Well, the—to get the claim allowed
20 to -- beyond recapture, I mean without recapturing subject matter?

21 JUDGE MacDONALD: No, the original claim.

22 JUDGE McKELVEY: No, you've got—to get claim 1 allowed in
23 the --

24 MR. YOUNG: Oh.

25

1 JUDGE McKELVEY: To get claim 1 allowed in the patent, you had
2 a mold carrier and a shell holder, and you limited the mold carrier to specific
3 mold carriers. Now you're taking that whole limitation out, so you're not
4 only recapturing what you amended the claim to be but the entire element.

5 MR. YOUNG: We—our position is that the application is entitled to
6 correct by reissue the failure to claim the subcombination. And when we --
7 when you look at how the subcombination to the mold assembly relates to
8 the amendment that was made, and consistent with the Board's decision in
9 the earlier appeal, when that limitation was added to recite that the mold
10 carriers were made in the form of enveloping structures, the mold shell was
11 implicitly limited, I think logically, so that it had to be a mold shell that was
12 configured and shaped to be able to work with the amended mold carrier.
13 But that is exactly the extent to which the mold shell relates to the narrowing
14 of the mold carrier. So now when you write a claim to the subcombination,
15 as the Board indicated in the earlier appeal, the mold carrier is not there.
16 But --

17 JUDGE McKELVEY: Well, I got a question about this --

18 MR. YOUNG: -- the same implicit --

19 JUDGE McKELVEY: -- this subcombination. I'm looking at the
20 reissue patent here.

21 MR. YOUNG: Yes, sir.

22 JUDGE McKELVEY: I have claim 23 in front of me. It says a mold
23 assembly for use in such and such comprising two mold shells, two mold
24 shell holders. Seems to me like—how's that a subcombination?

25

1 MR. YOUNG: Well, sir, the original patent claim was directed to a
2 device for manufacturing containers including a combination of elements
3 among which were the mold shells within which the containers, such as
4 thermoplastic bottles or the like, were formed. The mold shell holders in
5 which the mold shells are removably fastened and the mold carriers made in
6 the form of enveloping structures supporting the mold shell holders. So that
7 would be the combination.

8 The first reissue patent on the parent reissue application is directed to
9 a subcombination which includes the mold shell holders and the mold shells,
10 and the current claims are directed to a subcombination which includes only
11 the mold shells.

12 JUDGE McKELVEY: Now what did you just say there? Because
13 this claim 23 I have says comprising two mold shells and two mold shell
14 holders. So they both have to be there.

15 MR. YOUNG: Yes, sir, but the mold carrier is not there. So that is a
16 subcombination of the original patent claim.

17 JUDGE McKELVEY: The mold carrier is not—well, so what's the
18 difference between a mold shell holder and a mold shell carrier?

19 MR. YOUNG: Well, sir, if I could direct your attention to figure 1, if
20 you have the reissue patent in front of you.

21 JUDGE McKELVEY: Yes, I do.

22 MR. YOUNG: The mold shell is the innermost member 7.

23 JUDGE McKELVEY: All right.

24 MR. YOUNG: It provides the shape that the plastic is blown into to
25 actually form the shape of the bottle. Then the mold shell holder is 9, the

1 two rectangular half elements there that form the square around the mold
2 shell halves.

3 JUDGE McKELVEY: Yeah, I see.

4 MR. YOUNG: And the mold carrier is element 2.

5 JUDGE McKELVEY: How come claim 1 as allowed, says the mold
6 carriers are item 3?

7 MR. YOUNG: I'm sorry, you're correct. It's element 3.

8 JUDGE McKELVEY: Oh, it's element 3. So what's your—what you
9 say these allowed reissued claims took out element 3?

10 MR. YOUNG: Correct.

11 JUDGE McKELVEY: Is that what you're saying?

12 MR. YOUNG: That's correct.

13 JUDGE McKELVEY: And your current claims try to take out
14 element 3?

15 MR. YOUNG: Yes, sir, based on the same reasoning that the Board
16 applied in allowing claim 23 of the initial reissue patent.

17 JUDGE McKELVEY: What is the answer to that you've taken out an
18 entire element, and therefore you're recapturing subject matter that's way
19 broader than whatever you got allowed?

20 MR. YOUNG: Well, sir, I think the question is when you are
21 claiming the subcombination what is the relationship between what was
22 surrendered in connection with another element that's not in the
23 subcombination and the elements of the subcombination itself. And here we
24 would submit that that relationship is exactly claimed in the claim language
25 in the rejected claims in claim 48, for example, which is the matter in which

1 the mold shell had to be implicitly amended by the express amendment to
2 the mold carrier.

3 JUDGE McKELVEY: Say that again.

4 MR. YOUNG: Well, let me quote the Board's decision. The Board
5 in the prior decision found that the mold carrier was not an element of the
6 reissue subcombination claim. They found that the mold shell holder in that
7 application was implicitly limited by the amendment to the mold shell
8 carrier in the original prosecution, and they concluded the Appellants are not
9 recapturing subject matter pertaining to the claimed mold assembly that was
10 surrendered to get the 560 patent issued. And what we are saying in this
11 appeal is that looking at the subcombination claim that's only to the mold
12 shell that neither the mold shell carrier nor the mold shell holder are
13 elements of that particular subcombination claim, but the mold shell is
14 similarly limited by implication in the same way, that is that it has to be
15 shaped to be able to be supported by an enveloping mold carrier, and
16 therefore that we are not recapturing subject matter pertaining to the mold
17 shell assembly that was surrendered to get the 560 patent issued. And to the
18 extent that the --

19 JUDGE McKELVEY: Well, Mr. Young, I'm having a little trouble.
20 If a claim is unpatentable, if a claim to a combination of a carrier and a mold
21 is unpatentable over a reference, and it becomes patentable because the mold
22 carrier is limited, then if you take out the mold carrier aren't you in effect
23 recapturing subject matter, because your new claim will allow it to be
24 used—will allow the half molds to be used with any device just as long as
25 that device is capable of accepting this particular mold carrier?

1 MR. YOUNG: Well, I don't have a philosophical problem with that,
2 because the reissue statute is for the purpose of allowing broadening claims
3 in appropriate circumstances, and here the Examiner is agreeing that the
4 claim 2, the mold shell assembly, is patentable over the prior art and so the
5 question --

6 JUDGE McKELVEY: Well, let's say he hasn't rejected it. Let's put
7 it that way.

8 MR. YOUNG: Yes, sir.

9 JUDGE McKELVEY: I mean the assumption is he—there's no art
10 rejection but --

11 MR. YOUNG: Well, an applicant is entitled to a patent unless.

12 JUDGE MacDONALD: Can I ask a question here with respect to this
13 prior decision so I can fully understand what's going on here? Even though
14 it's not being said out loud, I'm understanding this to be your prior reissue
15 claimed an overlooked aspect of the—from the original application, but what
16 I'm not hearing anybody say is what that was, what was overlooked. You
17 keep saying subcombination. I'm assuming it's not just the subcombination
18 of what was in the claim, that something more was added to it when the
19 mold carrier was taken out. Were the other components of the
20 subcombination further limited? Is that also the situation we have here?
21 What's -- is it more than just taking something out, or is it simply an element
22 is being removed which strikes me as exactly recapture.

23 MR. YOUNG: Well, the aspect of the device that was amended to—I
24 mean you can broaden a claim by leaving out an element if there's no
25

1 recapture. So it's not—I don't think it's the fact that an element was—is left
2 out that makes it recaptured.

3 JUDGE MacDONALD: Well, in this case, my understanding it was
4 the element added by amendment to get the patent was totally removed.
5 How—in the case before us, how was the claim further narrowed in addition
6 to avoid recapture?

7 MR. YOUNG: It was narrowed by indicating that a remaining
8 element, the mold shell, has to be configured and shaped to be supported by
9 the enveloping structure, and the Board in the earlier decision said that is
10 over the Examiner's statement to—argument to the contrary found that that
11 is a structural limitation and that that maintained the implied limitation of
12 that mold shell, in that decision the mold shell holder, that was impliedly
13 present or created by the original amendment to the mold shell carrier.

14 JUDGE MacDONALD: So in essence, they found the limitation was
15 still there even though the claim had been restructured?

16 MR. YOUNG: Yes.

17 JUDGE MacDONALD: Let—that's not—clearly clearly not the issue
18 before us here, because you've already indicated that element is not required
19 by the claim. The carrier is not required by the claim.

20 MR. YOUNG: Oh, it's required by this claim in the same way that it
21 was required by the—in the mold shell holder claims of the first reissue.
22 The, the Board in fact acknowledged the mold carrier is not an element of
23 the claims before us but found that there was no recapture, because to the
24 extent that that amendment had any impact on the subcombination, that
25 relationship was maintained in the reissued claim.

1 JUDGE McKELVEY: But at the front of the hearing, you told me
2 you could infringe this claim with some apparatus that does not have the
3 mold carrier.

4 MR. YOUNG: Well, I also think that's true of the initial reissue
5 patent.

6 JUDGE McKELVEY: Well, I'm trying to figure out about this case.
7 I'm not worried about the reissue.

8 MR. YOUNG: Well, all right. I appreciate that, but I think that the
9 logic is exactly the same.

10 JUDGE McKELVEY: Well, tell me why that logic is right on the
11 merits.

12 MR. YOUNG: Because the original claim was amended to restrict the
13 mold carriers to enveloping structures. That impliedly limited the mold
14 shells to structures that are capable of being supported by that limited mold
15 carrier. In the reissue claim to the subcombination, that implied limitation is
16 retained.

17 JUDGE McKELVEY: Well, but doesn't the original claim require
18 that the mold carrier have that structure?

19 MR. YOUNG: It does.

20 JUDGE MacDONALD: I think I can state my concern here now, and
21 maybe you can explain why an artisan would view the original patent claims
22 this way. It sounds like you're saying the language in current claim 48, the
23 configured to support in the mold carrier made in the form enveloping
24 structures, is sufficient to bring that—at least to limit the shells themselves
25 in a certain way, and I think what I'm hearing, the point that's trying to be

1 made is or that would be persuasive if it's true is that that is all that's really
2 required to make these inventions patentable even in the original patent.
3 But the question for me is would an artisan have recognized that. Looking at
4 the amendment that was made to get the patent, would they have recognized
5 that oh, wow, it's just this piece of it that's required. It's the change to the
6 mold shell that you now have in claim 48. They would recognize you said
7 more than was necessary in the patent. You can now take that out, because
8 it's not really what's required to get the patent. To me that's the essence of
9 surrender, what was put in or what the public would understand was added
10 or an artisan would understand was added in order to get that patent.
11 Sometimes more is said than is necessary, and that's recognized by an
12 artisan. Well, I think an artisan would have agreed if presented with the
13 subcombination claim that it defined over the prior art.

14 MR. YOUNG: Well, I think the issue is at the time the patent came
15 out and they looked at the record, what would they understand? Example
16 would be you—three things are added by amendment, and an artisan knows
17 that two of them are conventional. They would not think those are what was
18 added to get the patent. And the third thing is clearly -- so if you come in
19 with a reissue, there's not going to be a problem if you explain those two
20 pieces are conventional, and an artisan would recognize that, and you show
21 evidence of that, and you want to remove them.

22 JUDGE MacDONALD: So my question is why is this removal of this
23 component that was modified by amendment to get the patent, why would an
24 artisan look at that and go oh, yeah, we knew that was not a problem to take
25 that out. That wasn't what was going to get this—make this patentable.

1 And it's just not leaping out to me that there is a subcombination by itself
2 from the original record that anyway we look at that and go oh, yeah, that's
3 the real point of the patent or from reading the specification oh, that's an
4 overlooked invention, because it's clearly present in the claim. So how can
5 it be overlooked? It's present in the original claim. So I'm not reaching the
6 same conclusion that the original panel did when I'm looking at this.

7 MR. YOUNG: Well, the extent to which the mold shells relate to the
8 subject matter that was surrendered, the fact that the mold carriers need to be
9 enveloping structures, is the extent to which they relate—the mold shell
10 relates to that is I think precisely claimed in the reissue application and --

11 JUDGE McKELVEY: Mr. Young, what does it mean that the mold
12 carriers are made in the form of enveloping structures? What's that
13 enveloping structures mean?

14 MR. YOUNG: I guess I hesitate to state a precise interpretation of
15 that. It's a long distance I guess from when that was inserted. It --

16 JUDGE McKELVEY: Well, give me an imprecise answer. That
17 would be fine.

18 MR. YOUNG: I believe that in—if I remember correctly, in the prior
19 art there were some structures that supported the mold shell holders that
20 were more or less point contact, arms coming in and supporting the mold
21 shell holders that way as opposed to a structure, a clamshell-type structure
22 that envelopes the mold shell holder.

23 JUDGE McKELVEY: Okay, so it's the fact that this structure is
24 hinged at one end we'll say is what you're talking about generally. I don't
25 need a precise answer. I'm just trying to figure out what that limitation --

1 MR. YOUNG: Well—pardon me, but the—since the word hinges is
2 not in the claim, I mean hinges is one way to—with a clamshell is one way
3 to have a structure that envelopes the mold shell holders.

4 JUDGE McKELVEY: Like is shown in figure 1. It shows it in open
5 position and in a closed position.

6 MR. YOUNG: Yes, sir.

7 JUDGE McKELVEY: Okay. I—that's fine. Is the essence of
8 recapture is designed to deal with the notice that the patent owner gives
9 when a patent comes out? We have recaptured it so that folks can look at
10 your patent and say well, he's not likely to go and recapture such and such
11 or broaden his claims later to such and such.

12 MR. YOUNG: Well, if that was a requirement then I don't think we
13 would need the intervening rights provisions which I think are designed to
14 protect someone who might not have been able to foresee how the
15 application or the patent might be broadened.

16 JUDGE McKELVEY: Well, then of course intervening rights don't
17 kick until you determine that something is patentable, and recapture is a
18 reason for saying it's not patentable. So what's intervening rights have to do
19 with this?

20 MR. YOUNG: Well, I think that the reissue statute is designed to
21 allow patentees to broaden their claims when appropriate, and I don't think
22 that there is in the statute a requirement that those possible changes be
23 foreseeable. I mean there—obviously the claims have to meet section 112.

24 JUDGE MacDONALD: But isn't the—isn't surrender really a
25 construction by the courts not by the statute? Don't they have other

1 concerns beyond what the statute says about, you know, the public being
2 able to rely on what's in the record, essentially when it's very particular that
3 something has been added to make the invention patentable, and the courts
4 are bothered when that gets removed?

5 MR. YOUNG: Well, I agree with that to the extent that the subject
6 matter has actually been surrendered, and in this case, we believe that the
7 patentee has a right to reissue to claim a subcombination that wasn't claimed
8 and therefore to look and see what was the impact on the surrender in the
9 original prosecution on a claim to the subcombination and I --

10 JUDGE McKELVEY: I have a couple other questions, Mr. Young. I
11 take it these claims all stand and fall together, 48 through 51? In other
12 words, if we deal with claim 48, do we decide the appeal?

13 MR. YOUNG: On the recapture issue, yes, sir.

14 JUDGE McKELVEY: Yes. You haven't argued it separately so --
15 Judge MacDonald, I don't have any more questions.

16 JUDGE MacDONALD: I have no further questions. Judge Garris?

17 JUDGE GARRIS: I just want to clarify. Do you consider that
18 claim 48 has been limited in some way that the original patent claim 1 was
19 not? I mean we understand the Examiner believes that it's broader, claim 48
20 is broader than patent claim 1, and my question to you is is there some other
21 feature of claim 48 that you have significantly narrowed relative to patent
22 claim 1 that we should be aware of in trying to assess this recapture issue? I
23 want to—guess I'm reaching toward is whether you consider that there's
24 some feature of claim 48 that had been overlooked in the original
25 prosecution of your patent.

1 JUDGE MacDONALD: Yeah, thank you. That was what—I was not
2 saying it as well as you did. That’s what I was hunting for. Is there
3 something here that we need to take into account, because the courts have
4 also been very clear that when the invention is directed to something that
5 was overlooked in the original patent that that’s perfectly appropriate for the
6 reissue statute, and recapture doesn’t even come into play in that situation.

7 MR. YOUNG: In the sense of the third part of the third part of the
8 test, no, not really. I mean the original claim was -- had the elements that I
9 think are responsible for patentability of the subcombination claims.

10 JUDGE McKELVEY: So in your opinion, the claim 47 is not
11 narrower in any respect than claim 1 as allowed?

12 JUDGE MacDONALD: I believe Judge McKelvey meant claim 48
13 rather than claim 47.

14 JUDGE McKELVEY: Forty-eight, yes.

15 MR. YOUNG: Correct, sir.

16 JUDGE MacDONALD: Okay, if there aren’t any other questions --

17 JUDGE GARRIS: I have no further questions.

18 JUDGE MacDONALD: Judge McKelvey?

19 JUDGE McKELVEY: No, I have no further questions.

20 JUDGE MacDONALD: I have no further questions unless you have
21 anything else you would like to say.

22 MR. YOUNG: Well, just that I understand that Board decisions are
23 not binding, but I do think that the claims that we have should be found to be
24 not recaptured in order -- well, that that would have to be the case to be
25 consistent with the logic of the prior Board decision and that in this case the

1 mold shell itself, the -- even less so recaptures subject matter pertaining to
2 the mold shell assembly than was the case with the mold shell holders
3 simply because that relationship is more remote.

4 JUDGE MacDONALD: Okay.

5 MR. YOUNG: And -- thank you very much.

6 JUDGE MacDONALD: Thank you.

7 (Whereupon, the hearing concluded at 2:40 p.m., on July 8, 2009.)
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